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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CARL PHILLIP GUSLER and RICK ALLEN HAMILTON, II

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Appeal 2007-1867

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Application 09/864,113

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Technology Center 3600

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Decided: November 7, 2007

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19Before HUBERT C. LORIN, JENNIFER D. BAHR¹, and ANTON W. FETTING,
20*Administrative Patent Judges.*

21FETTING, *Administrative Patent Judge.*

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DECISION ON REQUEST FOR REHEARING

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³ Administrative Patent Judge Bahr has replaced Administrative Patent Judge Levy on this panel, who retired August 3, 2007. *See In re Bose Corp.*, 772 F.2d 866, 5227 USPQ 1 (Fed. Cir. 1985).

1 The Appellants filed a REQUEST FOR REHEARING UNDER 37 CFR
2§ 1.197(b) on September 27, 2007.

3 The Examiner rejected claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27
4under 35 U.S.C. § 102(b) as anticipated by Odigo.com as evidenced by Surfing and
5Odigo.com web pages; claims 2, 5, 6, 11, 14, 15, 20, 23, and 24 under 35 U.S.C.
6§ 103(a) as unpatentable over Odigo.com and Tang; and claims 7, 16, and 25 under
735 U.S.C. § 103(a) as unpatentable over Odigo and Kenney. We affirmed these
8rejections in our July 27, 2007 Decision. The Appellants seek reconsideration of
9the decision to affirm these rejections.

10 We DENY the REQUEST FOR REHEARING.

11 ISSUES

12 The issue pertinent to this request is whether the Appellants have sustained
13their burden of showing that we erred in sustaining the rejections of claims 1, 3, 4,
148-10, 12, 13, 17-19, 21, 22, 26, and 27 under 35 U.S.C. § 102(b) as anticipated by
15Odigo.com as evidenced by Surfing and Odigo.com web pages; and claims 2, 5, 6,
1611, 14, 15, 20, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over
17Odigo.com and Tang.

18 The pertinent issue turns on whether certain shoppers in Odigo are otherwise
19disassociated with each other.

20 ANALYSIS

21 We found in our decision that claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26,
22and 27 under 35 U.S.C. § 102(b) are anticipated by Odigo.com as evidenced by
23Surfing and Odigo.com web pages. We stated the legal principle that claims are
24construed according to their broadest reasonable interpretation during patent

1prosecution. We found that the environment of the invention is a shopping
2environment, and that this is an inherently social environment. From this we found
3that the ordinary and usual meaning of the claim limitation “shoppers being
4otherwise disassociated with each other” is that of shoppers not spending time
5socially or keeping company (Decision 11).

6 The Appellants argue for a different definition which would define members of
7a common organization, such as Odigo.com group, as being "associated" by virtue
8of common membership only, without requiring a previous social contact between
9them. Thus, "disassociated" would cover two or more users who did not belong to
10a common group or organization, according to Appellant's argument (Request 1).

11 The Appellants contend that our construction was not commensurate with the
12disclosure and was overly narrow (Request 2). They contend that we
13misapprehended the definitions and scope of the terms “disassociate” and
14“associate” (Request 3).

15 We begin by pointing out that the attribute of association is one of affinity
16between entities, and thus depends on the criterion employed to judge such
17affinity. The claims do not explicitly recite the criterion to employ, and the
18Specification provides no lexicographic definition that incorporates a criterion.

19 This being the case, the scope of the claims is broad enough to encompass any
20criterion for judging whether the attribute of disassociation is met. The Appellants
21have the opportunity to explicitly narrow this scope by amendment if a more
22narrow scope is intended.

23 To support their contention, the Appellants rely on *Phillips v. AWH Corp.*, 415
24F.3d 1303 (Fed. Cir. 2005) to argue that the construction of “associate” should be
25given a special definition consistent with the Specification (Request 4) and on

1 Venn diagrams of hypothetical members of Odigo and other groups to argue that
2 the Appellants' construction is broader than that we relied upon in our decision
3 (Request 5-6).

4 Although the Specification may inform claim construction, in claim
5 construction during patent prosecution, pending claims are given their broadest
6 reasonable construction consistent with the specification. *In re Prater, id.* at
7 1404-05.

8 Nevertheless, the Specification provides no lexicographic definition of the
9 verbs "disassociate" or "associate" The Appellants argue that several examples in
10 the Specification of associated web surfers require us to construe "associated"
11 shoppers to include those who are joined in a common organization (Request 4).
12 The Appellants fail to recognize that exemplary embodiments, even preferred
13 embodiments, in the Specification are not to be read into the claims. *E-Pass*
14 *Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1368 (Fed. Cir. 2003).

15 As we stated above, the issue is what criterion of association is employed. The
16 Appellants are simply arguing that a criterion shown in examples in the
17 Specification should be inserted into the claim. The claim omits any explicit
18 criterion. The absence of an explicit criterion evidences a broad scope employing
19 any criteria reasonably considered by one of ordinary skill. It is up to the
20 Appellants to narrow the scope to certain criteria by amendment if that is their
21 intent.

22 The Appellants' argument that we did not apply the broadest reasonable
23 interpretation, based on the Appellants' Venn diagrams, is also misplaced. The
24 Appellants' argument comes down to the assertion that we did not apply the single
25 broadest criterion by which to measure association. But the claim breadth is

1encompassed by all of the potential reasonable criteria that one of ordinary skill
2would apply, since no explicit criterion is employed, not just one single broadest
3criterion. The issue actually is whether any such reasonable criterion, not just an
4asserted single broad criterion, of “association” leads to “being otherwise
5disassociated.”

6 In our decision, we found that the ordinary and usual meaning of the claim
7limitation “shoppers being otherwise disassociated with each other” is that of
8shoppers not spending time socially or keeping company (Decision 11). This
9construction, relying on the criterion of spending time socially, is clearly among
10the set of all potential criteria which the breadth of claim 1 encompasses, and is
11also consistent with the ordinary definition of the verb “associate”, and consistent
12with the disclosed environment of shopping. Thus the construction we applied is
13both reasonable and consistent with how one of ordinary skill would have
14understood the claim.

15 We therefore find the Appellants’ arguments unpersuasive and continue to
16construe the phrase “being otherwise disassociated with each other” as shoppers
17not spending time socially or keeping company.

18 Finally, the Appellants argued that our reference to criteria of association as
19membership in the human species was inappropriate and that online shopping is
20not a social environment (Request 7). The argument regarding membership in the
21human species refers to our findings that, for the claim to have meaning, some
22behavioral criterion must be employed to limit the degree of association, since
23mere membership as criteria associating shoppers would include membership for
24being members of the human species (Decision 12). Thus, we were distinguishing
25mere categorizational from behavioral criteria of association rather than finding a

1construction premised on this criterion of membership in the human species, and
2only using such a criterion as a straw man with which to show that some narrower
3criterion than mere membership in a common group must be employed for the
4claim scope to have any meaning.

5 The Appellants apparently argue that membership in a specific group, such as
6Odigo, presents the criteria they would employ. But the absence of such a criterion
7in the claim would mean that using membership as a criterion would open up the
8scope to any form of membership, including membership within the human race.
9Since all shoppers are so associated, none would be disassociated from each other
10according to mere membership criteria. This would lead to a nonsensical
11construction. Thus the need for a narrower criterion than mere membership.

12 The Appellants further argue that human race membership is an unreasonable
13criterion and presumably therefore irrelevant because: it relates to the biological
14art; not all humans share a common interest; and humans do not join the human
15race (Request 7). We disagree. Human race membership also relates to the
16sociological arts, within which shopping would clearly fall. Humans share a
17common interest in living and acquiring, both of which are accomplished by
18shopping. Humans join the human race at birth or somewhere during gestation.

19 Thus, the Appellants' arguments are unpersuasive as to our construction of the
20phrase "being otherwise disassociated with each other" as shoppers not spending
21time socially or keeping company. This is the sole argument for the Appellants'
22request for a rehearing.

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1 For the above reasons we are not convinced of reversible error in our
2decision. Accordingly, the Appellants' request for rehearing is denied,

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REHEARING DENIED

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